

**REMARKS/ARGUMENTS**

In the Office Action, the Examiner indicated that claims 1-21 were rejected.

**Objections to the Specification:**

In the Office Action, the Examiner objected to the specification on the grounds that the specification did not explicitly claim priority to prior application number 09/696,531. The Examiner explained as follows:

It is noted that this application appears to claim subject matter disclosed in prior Application No. 09/696,531, filed October 25, 2002. A reference to the prior application must be inserted as the first sentence of the specification of this application or in an application data sheet (37 CFR 1.76), if applicant intends to rely on the filing date of the prior application under 35 U.S.C. 119(e) or 120. See 37 CFR 1.78(a). For benefit claims under 35 U.S.C. 120, the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of all nonprovisional applications. Also, the current status of all nonprovisional parent applications referenced should be included.

Applicant has amended the specification to reflect that the application is a continuation of prior application serial number 09/696,531. It is believed that this amendment fully addresses the Examiner's objection.

**Rejections under 35 U.S.C. § 102:**

In the Office Action, the Examiner rejected claims 1-3, 5-6, 9-10, 12-16, and 19-20 under 35 U.S.C. § 102 as being anticipated by United States Patent Number 5,842,652

to Warsing et. al. Specifically, the Examiner stated the following:

Claims 1-3, 5-6, 9-10, 12-16, and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Warsing et al. (hereinafter "Warsing") (US 5,842,652). Warsing discloses a recycling center comprising: a transportable container (10); a partitions formed by the walls of holding bins (32, 34, 36, 38, 100, 116) defining a work area and a storage area (see figs. 3 and 5); said bins can be access from the exterior of the container through a portal (108); a compactor (claim 6); a power supply (40); and an opening (16) to access the work area (50) and an opening to unload the storage area (fig. 2). Further, Warsing discloses a method for collecting recyclable material comprising: placing and removing a transportable recyclable center at a location (fig. 1); receiving, sorting recyclable materials into bins (fig. 1), and storing the recyclable materials (fig. 1); compacting the recyclable material (claim 6, line 15); and placing materials into the bin through a portal (col. 9, line 15).

While Applicant does not agree with the Examiner's characterization of the Warsing reference, Applicant has nonetheless amended claims 1, 7 and 15 to more clearly describe a particular embodiment of Applicant's invention and thereby expedite prosecution. Applicant respectfully submits that these amendments do not add new matter and their entry is respectfully requested.

Applicant respectfully submits that the claims, as amended, even more clearly define over the cited Warsing reference. Upon a review of claims 1, 7 and 15 in light of the Warsing reference, Applicant respectfully submits that these claims are not anticipated by the Warsing reference, as it does not depict or describe each and every feature

and limitation recited in these claims. For the same reasons, the claims dependent on claims 1, 7 and 15 are not anticipated by the Warsing reference. Accordingly, Applicant respectfully submits that the Examiner's rejection of claims 1-3, 5-6, 9-10, 12-16, and 19-20 under 35 U.S.C. § 102 has been overcome.

**Rejections under 35 U.S.C. § 103:**

**Claims 4, 11, 17 and 21:**

In the Office Action, the Examiner rejected claims 4, 11, 17 and 21 under 35 U.S.C. § 103 as being obvious over Warsing et al. viewed in light of United States Patent Number 5,001,977 to Tracy. Specifically, the Examiner stated the following:

Claims 4, 11, 17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warsing et al., in view of Tracy (US 5,001,977). Warsing has been described above. Warsing does not disclose the power supply is a rechargeable battery and powering the compactor with the rechargeable battery. However, the patent to Tracy discloses a compactor (1) powered by a rechargeable battery (7). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the compactor of Warsing with a rechargeable battery, as taught by Tracy, in order to make the compactor a self-contained apparatus.

Claims 1, 9 and 15 have been amended to incorporate the limitations of now-canceled claims 4, 11 and 17. Claim 21 remains unamended.

**A Prima Facie Case of Obviousness Has Not Been Established**

Upon a review of amended claims 1, 9 and 15 and claim 21 in light of the Warsing and Tracy references, Applicant respectfully submits that the Examiner has not established a prima facie case that claims 1, 9, 15 and 21 are obvious in light of the Warsing and Tracy references, as these limitations do not, alone or in combination, depict or describe each and every feature and limitation recited in claims 1, 9, 15 and 21. Further, the Examiner has identified no motivation to combine the references in the manner suggested by the Examiner, and such combination would not be obvious to one of skill in the art.

**A Case of Obviousness Cannot be Sustained in the Wake of the Strong Evidence of Non-obviousness**

Even if the Examiner were to find that a prima facie case of obviousness exists, a holding of obviousness would be improper in light of the secondary indicia of non-obviousness of the present invention, particularly the long-felt need in the industry and the commercial success of the commercial embodiment of the invention.

**There is Evidence of Long-Felt Need**

The development of the present invention arose out of a long-felt need in the recycling industry. See *Declaration of Kevin Tippetts*, enclosed herewith, at ¶ 9.

Prior to the introduction of the present invention, it had been increasingly difficult to get contracts to open grocery store recycling centers from grocers, landlords and cities due to the size, aesthetics and out-dated equipment of then-existing collection centers. *Tippets Declaration*, ¶ 9. With parking spaces being at a premium, adding a recycling center that required 3 to 4 spaces was difficult for grocers and landlords to justify. *Tippets Declaration*, ¶ 9. These recycling containers were large and technologically outdated. *Tippets Declaration*, ¶ 9. Without conveniently located and desirable recycling operations, fewer centers were being opened and patronized. *Tippets Declaration*, ¶ 9. This is evident by the declining California recycling rate over the past years. (See *Tippets Declaration*, ¶ 9; Exhibit 1, Report from the California Department of Conservation.)

There was a demand by grocers, landlords and cities to develop an alternative to existing equipment options. *Tippets Declaration*, ¶ 9. Customers asked the inventors to develop a more workable solution. *Tippets Declaration*, ¶ 9. The present invention is the solution long requested by customers. *Tippets Declaration*, ¶ 9. In one commercial embodiment, the present invention will fit within the

confines of one standard grocery store parking space; it is totally portable, requires no electricity and fits aesthetically into any community. *Tippets Declaration*, ¶ 9.

**Evidence of Commercial Success**

Owing to its unique combination of features, the commercial embodiment of the present invention has met with surprising success in the marketplace. *Tippets Declaration*, ¶ 10. At the end of 2003, the assignee of the present invention had successfully signed new contracts with 4 major California grocers due to the development of the new design. *Tippets Declaration*, ¶ 10.

The first six months of 2004 have been unusual in site growth and performance. *Tippets Declaration*, ¶ 11. The assignee of the present invention has opened 40 sites in the period from January to June 2004, compared to only 10 sites in the period from January to June 2003. *Tippets Declaration*, ¶ 11. There has been a 300% increase in new site growth in 2004 as compared to 2003. *Tippets Declaration*, ¶ 11. Typically, new collection centers are slow to attract business and customers coming to recycle. *Tippets Declaration*, ¶ 11.

In the first six months of 2004, the assignee of the present invention has been averaging an increase of 12.3% in total average pounds recycled per site per day as compared to the same period in 2003. *Tippets Declaration*, ¶ 11; Exhibit 2. Typically, it would be expected that the average pounds per day per site would be less in 2004 verses 2003, owing to the increased number of sites. *Tippets Declaration*, ¶ 11. In other words, new sites typically produce lower volumes until the customer base is established, and such lower volumes would be expected to dilute the averages. *Tippets Declaration*, ¶ 11.

One strong competitive distinction for these grocers is the small footprint design of the present commercial embodiment of the present invention. *Tippets Declaration*, ¶ 12. In one commercial embodiment, the footprint is only 136 sq. feet (17' x 8') compared to a competitor at 476 square feet (24' x 17'). *Tippets Declaration*, ¶ 12. This design is one-third the size of its closest competing design. *Tippets Declaration*, ¶ 12. The inventors of the present invention were able to develop this small unit due to development of the battery-powered compaction and internal compartmentalization of material storage and

workspace, as outlined in the pending claims. *Tippets Declaration*, ¶ 12.

The commercial success of the commercial embodiment of the present invention is attributable to a combination of features, which include the following:

In one commercial embodiment, a collection center according to the present invention will fit within the confines of one standard grocery store parking space. *Tippets Declaration*, ¶ 13.

A collection center constructed according to the present invention can be made totally portable. *Tippets Declaration*, ¶ 13.

A collection center constructed according to the present invention may require no external electricity. *Tippets Declaration*, ¶ 13.

The above advantages are largely attributable to the integration of the following elements in a single unit:

The integration of a work area and a storage area in a single unit. *Tippets Declaration*, ¶ 14.

The integration of a compactor within the center. *Tippets Declaration*, ¶ 14.

The integration of a rechargeable battery to power the center. *Tippets Declaration*, ¶ 14.



In light of the above, Applicant respectfully submits that the Examiner's rejections of the claims under 35 U.S.C. § 103 cannot be sustained in light of the strong indicia of non-obviousness present in this case. The identified elements providing for the commercial success and addressing the long-felt need are clearly recited in each of claims 1, 9, 15 and 21. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of these claims under 35 U.S.C. § 103.

**The Remaining Dependent Claims Depend from One of Claims 1, 7 or 15**

In the Office Action, the Examiner rejected claim 7 as being unpatentable over Warsing et al., in view of U.S. Patent No. 5,111,727 to Schuize, Jr. The Examiner explained this rejection as follows:

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warsing et al., in view of Schuize, Jr. (US 5,111,927). Warsing has been described above. Warsing does not disclose a reverse vending machine (RVM). However, the patent to Schuize, Jr. teaches that it old and well known in the recycling art to provide a recycling container/apparatus with an RVM (fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the container of Warsing with an RVM, as taught by Schulze, Jr. in order to accept recycling materials in the absence of an operator.

The Examiner rejected claim 8 as being unpatentable over Warsing et al., in view of U.S. Patent No. 5,425,458 to

Gilcreest. The Examiner explained this rejection as follows:

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warsing et al., in view of Gilcreest et al. (hereinafter "Gilcreest") (US 5,425,458). Warsing has been described above. Warsing does not disclose the walls of the partition have doors. However, the patent to Gilcreest, in a related recycling art, discloses doors (26, 27, 28, 29, 30) in a partition that separate a storage area from a work area (see abstract and fig. 1). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the partitions of Warsing with doors, as taught by Gilcreest, in order to access the recyclable material deposited therein.

The Examiner rejected claim 18 as being unpatentable over Warsing et al., in view of U.S. Patent No. 5,078,567 to Lombardo. The Examiner explained this rejection as follows:

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Warsing et al., in view of Lombardo (US 5,078,567). Warsing has been described above. Warsing discloses an opening (16) to access the work area (50) and an opening to unload the storage area (fig. 2). Warsing does not disclose a front door to access the work area and a rear door to unload the storage area. However, the patent to Lombardo, in a related recycling art, discloses using doors to load and unload the storage area (figs. 1 and 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the openings of Warsing with doors, as taught by Lombardo, in order to provide a full and secure enclosure for the storage area.

In response to the above, Applicant respectfully submits that each of the above claims depends from one of amended claims 1, 9 or 15, which are allowable for the reasons elaborated above. Accordingly, Applicant

Appl. Ser. No. 10/606,815  
Amendment Dated August 11, 2004  
Reply to Office Action of March 11, 2004

respectfully submits that each of these claims is allowable  
and non-obvious over the cited art of record.

**CONCLUSION**

Applicant has made a diligent effort to advance the  
prosecution of this application by canceling claims,  
amending claims and/or pointing out with particularity  
herein how the claims now presented distinguish patentably  
over the cited art. An early Notice of Allowance of the  
pending claims is, therefore, respectfully solicited. The  
Examiner is authorized to charge any fees due in connection  
with this reply to Gardere Wynne Sewell deposit account no.  
07-0153.

Respectfully submitted,

Date: 8-11-2004



Kenneth T. Emanuelson  
Registration No. 46,684  
Attorney for Applicant(s)

Gardere Wynne Sewell LLP  
1601 Elm Street, Suite 3000  
Dallas, Texas 75201-4761  
Phone (214) 999-3000  
Fax (214) 999-3623